

## REMARKS

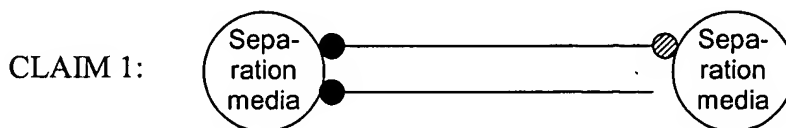
Claims 1-3, 6-9, 14-17, 19, 24-28, and 34-35 were pending. Claims 4-5, 10-13, 18, 20-23, 29, and 32-33 were withdrawn. The Examiner rejected claims 26 and 34, and indicated that claims 1-3, 6-9, 14-17, 19, 24, 25, 27, 28, and 35 are allowed. In light of the following remarks, Applicant respectfully requests reconsideration and allowance of claims 1-3, 6-9, 14-17, 24-28, 34, and 35. Applicant also requests rejoinder and allowance of claims 4-5, 10-13, 18, 20-23, 29, and 32-33.

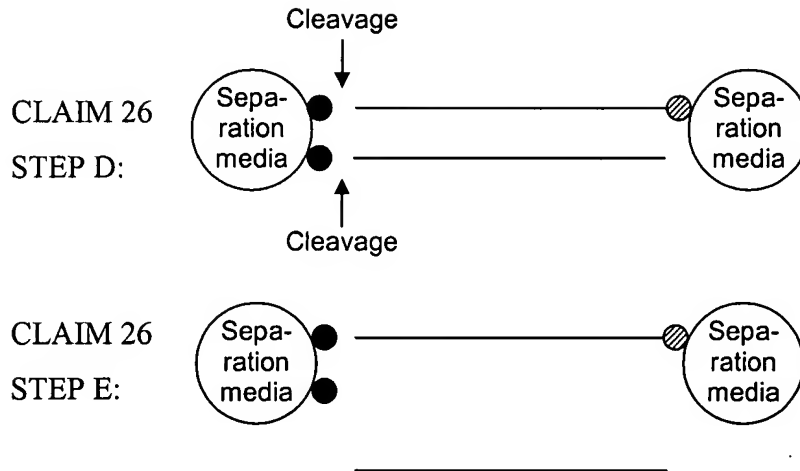
### Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 26 and 34 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner stated that step (d) of claim 26 requires only cleaving either the first separation tag or the second separation tag, and thus it is unclear how to elute an oligonucleotide lacking the first separation tag and an oligonucleotide lacking the second separation tag at the same time as recited in step (e) of the claim.

Applicant respectfully disagrees. Step (e) does not recite eluting two different oligonucleotides, one lacking the first separation tag and one lacking the second separation tag. Rather, step (e) of claim 26 recites eluting an oligonucleotide lacking the first separation tag and the second separation tag. Thus, the oligonucleotide eluted in step (e) lacks both separation tags.

It is possible to elute an oligonucleotide lacking both separation tags in step (e) of claim 26 because the plurality of oligonucleotides recited in claim 1 includes both bifunctional and non-bifunctional (e.g., monofunctional) oligonucleotides. Thus, both bifunctional and monofunctional oligonucleotides can be attached to the separation medium. Cleaving the separation tag from a monofunctional oligonucleotide in step (d) of claim 26 will result in an oligonucleotide that lacks both separation tags. This oligonucleotide can be eluted in step (e) of claim 26. The following diagrams are included for clarification.





Thus, it is clear that oligonucleotides lacking both the first separation tag and the second separation tag can be eluted in step (e) of claim 26. As such, claims 26 and 34 are definite.

In light of the above, Applicant respectfully requests withdrawal of the rejection of claims 26 and 34 under 35 U.S.C. § 112, second paragraph.

#### Allowable claims

Applicant acknowledges the Examiner's statement that claims 1-3, 6-9, 14-17, 24-28, 34, and 35 are allowed over the prior art. Applicant also notes that on the Summary page of the outstanding Action, the Examiner included claim 19 in the list of allowed claims.

#### Request for rejoinder of withdrawn claims

In the Response to Restriction Requirement mailed August 6, 2004, Applicant made several species elections that resulted in claims being withdrawn. Given the allowability of claims cited by the Examiner as being generic to the distinct species, Applicant respectfully requests consideration of claims to additional species as provided by 37 C.F.R. § 1.141. (*See*, MPEP § 809.02(a). *See, also*, MPEP § 818.03(d), which states that if the Office allows a linking claim, it is bound to withdraw the requirement and to act on all linked inventions.) Thus, Applicant requests rejoinder of the withdrawn claims as follows:

First, the Examiner stated that claim 1 is generic to claims 3-6. Claims 4 and 5 were withdrawn. Since claims 4 and 5 depend directly or indirectly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 4 and 5.

Second, the Examiner stated that claim 1 is generic to claims 8-13. Claims 10-13 were withdrawn. Since claims 10-13 depend indirectly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 10-13.

Third, the Examiner stated that claim 1 is generic to claims 17-23. Claims 18 and 20-23 were withdrawn. Since claims 20-23 depend directly or indirectly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 18 and 20-23.

Fourth, the Examiner stated that claim 27 is generic to claims 28-29. Claim 29 was withdrawn. Since claim 29 depends directly from claim 27, which appears to have been allowed, Applicant respectfully requests rejoinder of claim 29.

Finally, the Examiner stated that claim 1 is generic to claims 16, 32, and 33. Claims 32 and 33 were withdrawn. Since claims 32 and 33 depend directly from claim 1, which has been allowed, Applicant respectfully requests rejoinder of claims 32 and 33.

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Page : 10 of 10

Attorney's Docket No.: 11989-008001 / Q006US1

### CONCLUSION

Applicant submits that claims 1-3, 6-9, 14-17, 19, 24-28, and 34-35 are in condition for allowance, which action is respectfully requested. Applicant also requests rejoinder and allowance of claims 4, 5, 10-13, 18, 20-23, 29, and 32-33. The Examiner is invited to telephone the undersigned agent if such would further prosecution.

Applicant believes that no fee is due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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